UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,333	01/23/2001	Rolf Toft	SNY-P3846	9384

24337 7590 04/25/2005		EXAMINER
MILLER PATENT SERVICES		DENNISON, JERRY B
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RALEIGH, NC 27606	ART UNIT	PAPER NUMBER
	2143	

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/767,333	TOFT, ROLF
	Examiner	Art Unit	
	J. Bret Dennison	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 August 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

　 4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　 a)☐ All   b)☐ Some * c)☐ None of:

　　 1.☐ Certified copies of the priority documents have been received.

　　 2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　 3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　 Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　 Paper No(s)/Mail Date _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 1-04)　　　　　　　Office Action Summary　　　　　Part of Paper No./Mail Date 20050412

DETAILED ACTION

1.   This Action is in response to the Amendment for Application Number

09/767333 received on 6 August 2004.

2.   Claims 1-34 are presented for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

3.   Claim 10 recites the limitation "in a manner transparent to a user of the

Set Top Box program means for", and the limitation right after this one, "a boot

code displaying an icon representing an application". It is unclear to Examiner

what is transparent to the user.

Claim Rejections - 35 USC § 102

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 10, 18-20, and 26 are rejected under 35 U.S.C. 102(e) as being

anticipated by Hubacher et al. (U.S. Patent Number 6,539,473).

4.   Regarding claims 1, 10, 18, and 26 Hubacher disclosed on a client device

capable of operating using a plurality of operating systems on which a plurality of

applications run, a method of downloading an operating system and an

application which runs on the operating system, comprising

        a boot code of the client device providing a menu of selections

representing a plurality of available applications including said application

(Hubacher, col. 2, lines 49-55);

        receiving a signal representing a user's selection of a desired application

(Hubacher, col. 3, lines 3-5);

        responsive to receiving the signal, the boot code activating a download

manager of the client device (Hubacher, col. 8, lines 60-65,);

        the download manager managing a download of the operating system

associated with the desired application and the desired application in a manner

transparent to the user with no input from the user (Hubacher, col. 8, lines 60-

65), further comprising

        connecting to a service provider (Hubacher, col. 8, lines 60-65);

        downloading the operating system associated with the desired application

from the service provider (Hubacher, col. 8, lines 60-65);

        downloading the desired application (Hubacher, col. 10, line 60 through

col. 11, line 5); and

        installing and executing the operating system and the desired application

(Hubacher, col. 8, lines 49-67).

5.   Regarding claims 19 and 20, Hubacher disclosed the features of the

invention, substantially as claimed, as described in claim 18, including wherein

the program means is stored in Read Only Memory (Hubacher, col. 8, lines 50-

67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described
> as set forth in section 102 of this title, if the differences between the subject matter sought to
> be patented and the prior art are such that the subject matter as a whole would have been
> obvious at the time the invention was made to a person having ordinary skill in the art to which
> said subject matter pertains. Patentability shall not be negatived by the manner in which the
> invention was made.

Claims 2-7, 13-16, 21-24, and 29-33 are rejected under 35 U.S.C. 103(a)

as being unpatentable over Hubacher in view of Ananda (U.S. Patent Number

5,548,645).

6.   Regarding claims 2 and 30, Hubacher disclosed the features of the

invention, substantially as claimed, as described in claims 1 and 26. Hubacher

does not explicitly state wherein the application comprises an entertainment

network service application.

In an analogous art disclosed wherein the application comprises an

entertainment network service application (Ananda, col. 6, lines 34-45).

Hubacher provides a method and system, which before booting up, allows

a user of a workstation to select from a menu of programs, and based on the

selection, the corresponding boot attempt is made. The corresponding operating system and programs are downloaded and set up on the user's workstation (Hubacher, col. 8, lines 60-67).

Ananda provides a system for secure access and execution of application software by a first computer while a communication link is maintained between the first computer and a second computer (Ananda, see Abstract)

Since Hubacher provides for downloading of programs from a central server, a network administrator would have been motivated to combine Ananda with Hubacher to provide another remote application downloading system in order to provide a secure access and execution of application software (Ananda, col. 5, lines 40-41).

7.   Regarding claims 3, 5, 15, 16, 23, 24, 31, and 33 Hubacher and Ananda disclosed the features of the invention, substantially as claimed, as described in claims 1, 2, 10, 18, and 26, including wherein the connecting comprises:

connecting to a Master Server (Hubacher, col. 2, lines 45-60, Ananda, col. 2, lines 55-60);

connecting by dialing a telephone number (Ananda, col. 6, lines 64-65, Ananda teaches that the communication path is a telephone transmission line); Ananda also discloses a client connecting to a server through a communications link. However, Hubacher and Ananda do not explicitly state obtaining a URL and connecting to the URL via a service provider. However, using a service provider to connect to a server through a URL is well known in the art of networking.

Therefore it would have been obvious to one in the ordinary skill in the art at the time of the invention to connect to a URL through their service provider to gain access to the server and retrieve requested data. See motivation for claims 2 and 30.

8.   Regarding claims 4, 6, and 32, Hubacher and Ananda disclosed the features of the invention, substantially as claimed, as described in claims 3, 5, and 26, including authenticating the client device at the Master Server (Ananda, col. 8, lines 10-30). See motivation for claims 2 and 30.

9.   Regarding claims 7 and 29, Hubacher and Ananda disclosed the features of the invention, substantially as claimed, as described in claims 1 and 26, including wherein the downloading stages comprise downloading to a flash memory element (Ananda, col. 7, lines 15-17). See motivation for claims 2 and 30.

10.   Regarding claims 13 and 21, Hubacher disclosed the features of the invention, substantially as claimed, as described in claims 10 and 18. However Hubacher did not explicitly state wherein the program means further comprises means for collecting registration information from a user. In an analogous art, Ananda disclosed collecting registration information (Ananda, col. 8, lines 38-40). See motivation for claims 2 and 30.

11.   Regarding claims 14 and 22, Hubacher disclosed the features of the

invention, substantially as claimed, as described in claims 10 and 18. However

Hubacher did not explicitly state wherein the program means further comprises

means for exchanging authentication information with a Master Server. In an

analogous art, Ananda disclosed exchanging authentication information with a

master server (Ananda, col. 8, lines 10-30).

        Claims 8, 9, 11, 12, 17, 25, 27, 28, and 34 are rejected under 35 U.S.C.

103(a) as being unpatentable over Hubacher in view of Wilde et al. (U.S. Patent

Number 6,446,260).

12.   Regarding claims 8 and 34, Hubacher disclosed the features of the

invention, substantially as claimed, as described in claims 1 and 26. However,

Hubacher does not explicitly state including wherein the downloading stages

comprise downloading a compressed image of the operating system and

application.

        In an analogous art, Wilde disclosed wherein at the time of downloading

the operating system, compressed operating system files are downloaded

(Wilde, Fig. 2, 100).

        Hubacher provides a method and system, which before booting up, allows

a user of a workstation to select from a menu of programs, and based on the

selection, the corresponding boot attempt is made. The corresponding operating

system and programs are downloaded and set up on the user's workstation (Hubacher, col. 8, lines 60-67).

Wilde provides a method and apparatus for providing personalization parameters to allow and operating system to download and install itself on a computer system with the provided personalization parameters (Wilde, see Abstract).

Therefore, since Hubacher provides a method for downloading an operating system after the user selects programs from a menu, it would have been obvious to a network administrator to incorporate the method of downloading and installing an operating system of Wilde into Hubacher to provide an improvement in the automated deployment of operating systems over a network to avoid the need to manually execute API's to configure an operating system with parameters which cannot be configured using an answer file (Wilde, col. 3, lines 35-45).

13. Regarding claims 9, 17, and 25, Hubacher disclosed the features of the invention, substantially as claimed, as described in claims 1, 10, and 26. However, Hubacher does not explicitly state decompressing the operating system and the application prior to the executing stage. In an analogous art, Wilde teaches decompressing the operating system and the application prior to the executing stage (Wilde, Fig. 8, 152). See motivation for claims 8 and 34.

14.   Regarding claims 11, 12, 27, and 28, Hubacher and Wilde disclosed the

features of the invention, substantially as claimed, as described in claims 10, and

26, including wherein the program means is stored in Read Only Memory

(Hubacher, col. 2, lines 50-65).

Response to Amendment

15.   Applicant's arguments and amendments filed on 6 August 2004 have

been carefully considered but they are not deemed fully persuasive. Applicant's

arguments are deemed moot in view of the following new grounds of rejection as

explained here below, necessitated by Applicant's substantial amendment (i.e.,

by incorporating new limitations in to independent claims which require further

search and consideration) to the claims which significantly affected the scope

thereof.

16.   Applicant's arguments drawn toward distinction of the claimed invention

and the prior art teachings on this point are not considered persuasive. It is also

clear to the Examiner that Hubacher et al. clearly teaches the independent claims

of the Applicant's claimed invention.

17.   In response to applicant's argument that there is no suggestion to combine

the references, the examiner recognizes that obviousness can only be

established by combining or modifying the teachings of the prior art to produce

the claimed invention where there is some teaching, suggestion, or motivation to

do so found either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941

(Fed. Cir. 1992). In this case, Hubacher provides a method and system, which

before booting up, allows a user of a workstation to select from a menu of

programs, and based on the selection, the corresponding boot attempt is made.

The corresponding operating system and programs are downloaded and set up

on the user's workstation. Therefore it would have been obvious to a network

administrator to incorporate the teachings found in Ananda (to provide another

remote application downloading system in order to provide a secure access and

execution of application software) and Wilde et al. (Hubacher to provide an

improvement in the automated deployment of operating systems over a network

to avoid the need to manually execute API's to configure an operating system

with parameters which cannot be configured using an answer file) as shown in

the above rejection.

18.   Applicant's arguments with respect to claims 1-34 are deemed moot in

view of the following new grounds of rejection, necessitated by Applicant's

amendment to the claims, which significantly affected the scope thereof.

19.   Furthermore, as it is Applicant's right to continue to claim as broadly as

possible their invention, it is also the Examiner's right to continue to interpret the

claim language as broadly as possible. It is the Examiner's position that the

detailed functionality that allows for Applicant's invention to overcome the prior

art used in the rejection, fails to differentiate in detail how these features are

unique. As it is extremely well known in the networking art as already shown by

Hubacher as well as other prior arts of records disclosed, program selection

before boot up is taught as well as other claimed features of Applicant's invention. By the rejection above, the applicant must submit amendments to the claims in order to distinguish over the prior art use in the rejection that discloses different features of Applicant's claimed invention.

20.   It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

21.   Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully

requested to indicate the portion(s) of the specification which dictate(s) the

structure relied on for proper interpretation and also to verify and ascertain the

metes and bounds of the claimed invention.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of

time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire

THREE MONTHS from the mailing date of this action. In the event a first reply is

filed within TWO MONTHS of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory

period, then the shortened statutory period will expire on the date the advisory

action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from

the examiner should be directed to J. Bret Dennison whose telephone number is

(571)272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, David A Wiley can be reached on (703)308-5221. The

fax phone number for the organization where this application or proceeding is

assigned is 703-872-9306.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information

for published applications may be obtained from either Private PAIR or Public

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free).

J. B. D.
Patent Examiner
Art Unit 2143
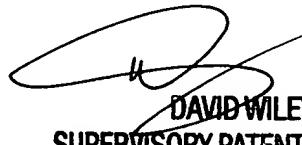
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